

REMARKS

This Amendment is submitted in response to the Office Action dated December 18, 2004. In the Office Action, the Patent Office rejected Claims 1-18 under 35 U.S.C. §103(a) as being obvious over *Greco et al.* (U.S. Patent Pub. No. 2002/0120680 A1).

By the present Amendment, Applicant amended Claims 1-3 and 12 and submits that the amendments to the claims overcome the rejection by the Patent Office for the reasons that follow and place the application in condition for allowance.

With respect to the rejection of Claims 1-18 under 35 U.S.C. §103(a) as being obvious over *Greco et al.*, Applicant submits that this rejection has been overcome in view of the amended claims and for the reasons that follow.

In the Office Action, the Patent Office asserts:

Greco et al. teach a method and system for providing electronic document services, comprising:

As per claims 1 and 12,
providing a browser to locate a service provider on the Internet [0006]; [0051]; [0089];

providing a database of information accessible by parties wherein the database of information includes information such as requirements of effectuate delivery of a special mailing, forms, and addresses [0012]; [0013];

inputting information into the database regarding demographics [0082]; [0084];

selecting a type of communication by one of the users [0062]; [0084];

automatically delivering an item by the special service [0062] - [0069];

generating and transferring user fees, postage costs, and special service mail provider costs [0097].

Greco et al. do not specifically teach that providing a browser to locate a service provider on the Internet includes providing a website.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify *Greco et al.* to include providing a website of a service provider, because it appears that the claimed features do not distinguish the invention over similar features in the prior art, and the teachings of *Greco et al.* would perform the invention as claimed by the applicant with either specifically teaching the website, or not.

Independent Claim 1 requires a system to assist with preparation and automatic delivery of a communication by a special service having a computer accessible site that provides automatic processing of a mailing requiring delivery by a special service and automatic payment of fees associated with the delivery. Further, Claim 1 requires a system having a database which includes a plurality of communications wherein one of the plurality of communications in the database is selected via the computer accessible site and prepared for automatically delivery via the database.

Independent Claim 12 requires method for assisting with preparation and automatic delivery of a communication requiring delivery by a special service having the step of providing a computer-accessible site and inputting information into the database regarding demographics via the computer-accessible site wherein the requirements to effectuate delivery of the special mailing are based on the demographics. Further, Claim 12 requires the step of selecting one of the communications in the database and automatically delivering one of the communications by the special service based on the requirements to effectuate delivery of the special mailing and the demographics. Moreover, Claim 12 requires the step of automatically paying fees associated with postage and services.

Contrary to the assertions of the Patent Office, *Greco et al.* merely teach systems and methods which facilitate the obtainment of electronic document services in a secure manner. Additionally, *Greco et al.* teach that "there is a need for mechanisms that facilitate the obtainment of document-related services in a secure manner." Further, *Greco et al.* teach that "the system activates a graphical user interface within the document preparation software application, contacts a

server to identify available document services, and configures the graphical user interface based on the available document services." Moreover, Greco et al. teach that "the system detects selection of one of the available document services and provides the document from the document preparation software application to one or more service providers for performance of the selected document service."

(1)
(5)
(6) Nowhere does Greco et al. teach or suggest a computer accessible site that provides automatic processing of a mailing requiring delivery by a special service and automatic payment of fees associated with the delivery as required by Claim 1. Further, nowhere does Greco et al. teach or suggest a method for assisting with preparation and automatic delivery of a communication requiring delivery by a special service having the step of providing a computer-accessible site and automatically paying fees associated with postage and services as required by Claim 12. Still further, the Patent Office admits that "Greco et al. do not specifically teach that providing a browser to locate a service provider on the Internet includes providing a website." Moreover, Greco et al. merely teach that "the Overnight Courier Service button 410 may initiate overnight delivery of the document via a

courier service" and that "this function may provide a price comparison for shipping options, payment via credit or debit card." Additionally, *Greco et al.* teach that "the Traditional Mail Service button 425 may initiate a function to permit a user to have a document certified, registered, and delivered by the U.S. Post Office even after normal postal hours" and that "this function may provide a price comparison for shipping options and payment via credit or debit card." Therefore, *Greco et al.* do not teach or suggest a computer accessible site that provides automatic payment of fees associated with the delivery or a method having the step of automatically paying of fees associated with postage and services as required by Claims 1 and 12, respectively.

Furthermore, *Greco et al.* actually teach away from a computer accessible site which provides automatic payment of fees associated with the delivery and a method having the step of automatically paying fees associated with postage and services as specifically defined in Claims 1 and 12, respectively, of the present invention. More specifically, *Greco et al.* teach that "the server 120 may also consolidate the fees incurred for various document-related services requested by the user and provide a periodic (e.g., monthly)

bill to the user" and that "the bill may itemize the various services to aid the user in identifying the costs". Thus, the system and/or method of Greco et al. having the server 120 which may consolidate the fees incurred for various document-related services requested by the user and provide a periodic (e.g., monthly) bill to the user actually teach away from the system and method defined by Claims 1 and 12, respectively, of the present invention. Namely, Greco et al. teach away from a computer accessible site that provides automatic payment of fees associated with the delivery and a method having the step of automatically paying fees associated with postage and services as required by Claims 1 and 12, respectively.

Nowhere does Greco et al. teach or suggest a system having a database which includes a plurality of communications wherein one of the plurality of communications in the database is selected via the computer accessible site and prepared for automatically delivery via the database as required by Claim 1. Further, nowhere does Greco et al. teach or suggest a method having the step of selecting one of the communications in the database via the computer-accessible site as required by Claim 12. On the contrary, Greco et al. merely teach that

"the graphical user interface is implemented within a document preparation application used to create the document." Further, *Greco et al.* teach that "the document preparation software 320 may include conventional word processing software, such as Microsoft Word, Corel WordPerfect, and Lotus WordPro; spreadsheet software, such as Microsoft Excel; financial analysis software, such as Quicken Quickbooks; and/or other types of software, such as Microsoft PowerPoint and Adobe Acrobat." Still further, *Greco et al.* teach that "the document services relate to the document(s) created by the user in the document preparation software application".

Nowhere does *Greco et al.* teach or suggest a method having the step of inputting information into the database regarding demographics via the computer-accessible site wherein the requirements to effectuate delivery of the special mailing are based on the demographics as required by Claim 12. Further, nowhere does *Greco et al.* teach or suggest a method having the step of automatically delivering one of the communications by the special service based on the requirements to effectuate delivery of the special mailing and the demographics as required by Claim 12. On the contrary, *Greco et al.* merely teach that "the particular service providers included in the

link information field 722 and/or the service provider information field 724 may be determined from one or more factors, such as the type of service they provide, the user's location, the user's preference, financial or business considerations, etc." Further, *Greco et al.* teach that "the user may provide the document and identify the address of the recipient of the document electronically to a secure location of a service provider, which may include a messenger delivery service or a service provider operating in partnership with a messenger delivery service." Therefore, *Greco et al.* do not teach or suggest the steps of inputting information into the database regarding demographics via the computer-accessible site wherein the requirements to effectuate delivery of the special mailing are based on the demographics and automatically delivering one of the communications by the special service based on the requirements to effectuate delivery of the special mailing and the demographics as required by Claim 12.

Moreover, with respect to the rejection of Claims 1 and 12 under 35 U.S.C. §103(a), one of ordinary skill in the art at the time of Applicant's invention would never have been motivated to modify *Greco et al.* in the manner suggested by

the Patent Office in formulating the rejection of the claims under 35 U.S.C. §103(a). It is submitted that the question under §103 is whether the art would suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teaching of the reference in its entirety, would have been obvious to one of ordinary skill in the art at the time the invention was made. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's invention, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of *Greco et al.* in mind, as enumerated above, no reason or suggestion in the

evidence of record exists why one of ordinary skill in the art at the time of Applicant's invention would have been led to modify *Greco et al.* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103(a). Even assuming that one having ordinary skill in the art could somehow have modified *Greco et al.*, the reference still lacks the critical features and steps positively recited in Claims 1 and 12, respectively. Accordingly, the rejection of Claims 1 and 12 under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

In view of the foregoing remarks and amendments, Applicant respectfully submits that the rejection of Claims 1-18 under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

Claims 2-11 depend from Claim 1; and Claims 13-20 depend from Claim 12. These claims are also believed allowable since each sets forth additional structural elements and novel steps of Applicant's system and method, respectively.

In view of the foregoing remarks and amendments, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is in condition for allowance. If, however, any outstanding issues remain,

Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

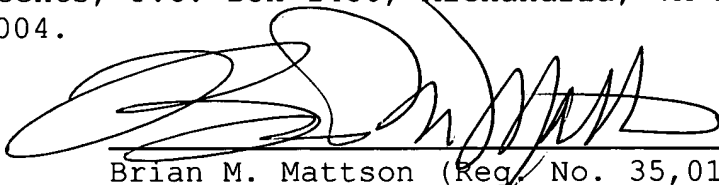
 Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this **Amendment** is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 8, 2004.


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